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09/918,760	08/01/2001	Steven R. Moore	D/A1143	2731

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EXAMINER

NGUYEN, HOAI AN D

ART UNIT

PAPER NUMBER

2854

DATE MAILED: 06/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicant(s)

09/918,760

Applicant(s)

MOORE ET AL.

Examiner

Hoai-An D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in

- (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or
- (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;

2. Claims 1-12 and 14-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Narita (US 0055149217).

#### **Narita discloses a system comprising:**

- A drive motor (FIG.14, step motor 54) that can rotate in increments, with regard to claims 1, 9, 16, 20 and 24;
- A drive train (FIG.14, gear train 55) driven by the drive motor, with regard to claims 1, 9, 16, 20 and 24;
- At least one substrate transport mechanism (FIG.14, medium feed roller 57 and shaft 56) connected to the drive train and driven by the drive motor therethrough with regard to claims 1, 9, 16, 20 and 24;
- A medium feed mechanism, which plays the role of the substrate advancer and the substrate final advancer, in communication with the drive motor emitting control

- signals to the drive motor that cause the substrate to move to a point short of an intended destination (column 2, lines 30-37) or to continue to the intended destination (column 2, lines 48-57), with regard to claims 1, 9, 16, 20 and 24;
- The means for stopping (the clutch mechanism) operates in response to a means for sensing substrate position (medium sensor) (column 7, lines 63-68 and column 8, lines 1-23), with regard to claim 2;
  - The means for finally advancing comprises means for incrementally advancing the substrate (column 1, lines 7-11), with regard to claim 3;
  - The drive motor is a position-controlled servo motor (column 5, lines 1-25), with regard to claims 4 and 10;
  - The drive motor is a stepper motor (column 1, line 38), with regard to claims 5, 11 and 21;
  - The means for finally advancing operates the stepper motor in full steps, in fractions of steps, and in microsteps (column 1, lines 49-54), with regard to claims 6, 7, 8, 21, 22 and 23;
  - The signals from the medium feed mechanism, which plays the role of the substrate advancer, cause the drive motor to stop the substrate a predetermined number of increments from the intended destination (column 2, lines 30-37), with regard to claims 12 and 18;
  - The signals from the medium feed mechanism, which plays the role of the substrate final advancer, cause the drive motor to advance by the predetermined number of increments (column 2, lines 48-57), with regard to claims 14 and 19;

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- A medium sensor 12 (FIG.4) is implemented in this medium feed mechanism. As an inherent feature, it is somehow sending a signal to the medium feed mechanism, which plays the role of the substrate final advancer, to stop the drive motor when it detects that the substrate has arrived at the intended destination, (column 4, lines 61-67), with regard to claims 15 and 17;

The method claims 6-8 and 16-23 are clearly rejected based upon the rejections of the system claims above of the system since the claimed method steps are met by the normal and intended use of the system of Narita.

3. Claims 1, 3-12, 14, 16 and 18-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Nureki (US 006312177 B1).

**Nureki teaches a system comprising:**

- A drive motor (FIG.4, step motor 401) that can rotate in increments, with regard to claims 1, 9, 16, 20 and 24;
- A drive train (FIG.4, gear train 402 and 403) driven by the drive motor, with regard to claims 1, 9, 16, 20 and 24;
- At least one substrate transport mechanism (FIG.4, platen roller 57 and shaft 56) connected to the drive train and driven by the drive motor therethrough with regard to claims 1, 9, 16, 20 and 24;
- A motor control means, which plays the role of the substrate advancer and the substrate final advancer, in communication with the drive motor emitting control signals to the drive motor that cause the substrate to move to a point short of an

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- intended destination (column 4, lines 32-35) or to continue to the intended destination (column 4, lines 35-38), with regard to claims 1, 9, 16, 20 and 24;
- The means for finally advancing comprises means for incrementally advancing the substrate (column 1, lines 10-12), with regard to claim 3;
  - The drive motor is a position-controlled servo motor (column 1, lines 24-33 and FIG.2), with regard to claims 4 and 10;
  - The drive motor is a stepper motor (column 1, line 15), with regard to claims 5, 11 and 21;
  - The means for finally advancing operates the stepper motor in full steps, in fractions of steps, and in microsteps (column 3, lines 1-8), with regard to claims 6, 7, 8, 21, 22 and 23;
  - The signals from the paper advance mechanism, which plays the role of the substrate advancer, cause the drive motor to stop the substrate a predetermined number of increments from the intended destination (column 1, lines 24-57), with regard to claims 12 and 18;
  - The signals from the paper advance mechanism, which plays the role of the substrate final advancer, cause the drive motor to advance by the predetermined number of increments (column 2, lines 25-33), with regard to claims 14 and 19;

The method claims 6-8 and 16-23 are clearly rejected based upon the rejections of the system claims above of the system since the claimed method steps are met by the normal and intended use of the system of Nureki.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Narita.

Narita teaches all that is claimed except that Narita does not specifically teach a backlash error in his system, but it is clear that at least under certain circumstances the backlash error must be smaller than the predetermined number of increments so that his system can function properly. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the predetermined number of increments is greater than a number of increments representing a total possible backlash error in the drive train since this is what would be expected during the normal and intended use of the system of Narita.

6. Claims 2, 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nureki in view of Barker et al. (4,519,700).

**Nureki teaches all that is claimed, except for the followings:**

- A means for sensing substrate position with regard to claims 2, 15 and 17

**However, Barker et al teaches that a system comprising:**

- A means for sensing substrate position (FIG. 1, paper sensor 32 and column 6, lines 53-61).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Nureki to incorporate the teaching of a means

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for sensing substrate position taught by Barker et al. since Barker et al. teaches that such an arrangement is beneficial to control the feeding of the printing medium based on the signal from the optical sensor, so it will allow a printer to print images with high precision.

7. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nureki.

Nureki teaches all that is claimed except that Nureki does not specifically teach a backlash error in his system, but it is clear that at least under certain circumstances the backlash error must be smaller than the predetermined number of increments so that his system can function properly. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the predetermined number of increments is greater than a number of increments representing a total possible backlash error in the drive train since this is what would be expected during the normal and intended use of the system of Nureki.

### ***Response to Arguments***

8. Applicant's arguments filed April 15, 2003 have been fully considered but they are not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., reducing backlash) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The followings reasons explain why applicant's arguments are not persuasive:

- The claims do not define what a final intended position is. Therefore, a final intended position could be any positions along the path of travel of the media



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including, for example, a discharge paper tray which is clearly located after position in which the media has been previously stopped along the path of travel.

- The claim preamble (backlash reduction) failed "to give life, meaning and vitality" to the claims 1, 9, 16 and 24. It is noted that "[A] claim preamble has the import that the claim as a whole suggests for it." *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). In the present claims, the preamble does not give life, meaning and vitality to the claims since the respective bodies of the claims define complete apparatuses and method which do not rely on the preambles for completeness.

### ***Conclusion***

**9. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### CONTACT INFORMATION

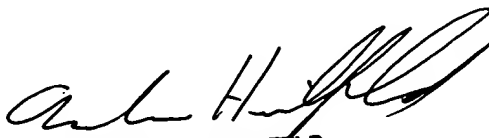
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoai-An D. Nguyen whose telephone number is (703) 305-3343. The examiner can normally be reached on M-F (8:00 - 5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew H. Hirshfeld can be reached on (703) 305-6619. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Hoai-An D. Nguyen  
Examiner  
Art Unit 2854

HADN  
June 23, 2003

  
ANDREW H. HIRSHFELD  
SUPERVISORY PATENT EXAMINER  
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